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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,920	06/26/2001	Kenneth A. Nicoll	8716.00	1995
26889	7590	10/02/2006	EXAMINER	
MICHAEL CHAN NCR CORPORATION 1700 SOUTH PATTERSON BLVD DAYTON, OH 45479-0001				HARBECK, TIMOTHY M
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/891,920	NICOLL ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Timothy M. Harbeck	3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 July 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Graef et al (hereinafter Graef, US 6,484,380 B2).

**Re Claim 12:** Graef discloses a media module for use in a self-service terminal, the media module comprising:

- Means defining a media dispense path (Fig 1, See arrows related to Refs 54, 56, 60 and 62)
- A plurality of media containers (Fig 1, Refs 44, 46, 48 and 50)
- A friction pick mechanism associated with each media container within the media module for picking media from the media container (Fig 1, Refs 34, 36, 38, and 40) and transferring the picked media to the media dispense path (Fig 1, Refs 54, 56) for transporting media from the media dispensing module (Fig 1, Refs 60, 62, 68)

**Re Claim 14:** Graef discloses a method of dispensing media from a self-service terminal, the method comprising the steps of:

- Selectively removing media from one of a plurality of media containers disposed within a media module, wherein each of the media containers within the media module includes a friction pick mechanism (Fig 1, Refs 34, 36, 38, and 40) for picking media from the media container and transferring the picked media to a media dispense path for removing the media from the media module (Column 7, lines 27-31 and (Fig 1, Refs 60, 62, 68)
- Presenting removed media to a user (Column 7 line 63- Column 8, line 15)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graef in view of Lynch et al (hereinafter Lynch, US 6,029,971).

**Re Claim 1:** Graef discloses a self-service terminal comprising:

- A plurality of media modules (Fig 1, 44, 46, 48, 50; Column 7, lines 42-52)), each module operatively associated with a pick mechanism for picking media from the module (Fig 1, 34, 36, 38, 40; Column 7, lines 26-41) and transferring the picked media to a media dispense path (Column 7, lines 53-62), wherein at least one of the modules being associated with

a friction pick mechanism (See Fig 2 and description Column 8 line 39-  
Column 10 line 50; cites friction portions of picking mechanism)

In addition, Graef notes that ATMs can be used to dispense a variety of different medias including cash, tickets, scrip, vouchers or other documents (Column 1, lines 18-35). Furthermore, Graef discloses that the modules may hold a variety of different types of documents in the same machine (Column 7, lines 46-48).

Graef does not explicitly disclose at least one module being associated with a vacuum pick mechanism. Lynch discloses that sheet feeding apparatus, such as the one disclosed by Graef "are commonly of either the vacuum pick or friction pick type," and depending on the type of media involved cites the advantages and disadvantages for each (Column 1, lines 5-20). Some media as Lynch points out is better served with a friction mechanism (medias that need a high feed rate), while other media would be better served with a vacuum mechanism (high porous). Thus, it would have been obvious to anyone of ordinary skill at the time of invention to include the teachings of Lynch to the disclosure of Graef so that an ATM containing multiple media types, can distribute the different types of media in the most efficient and practical way possible.

**Re Claim 2:** Graef in view of Lynch discloses the claimed terminal and Lynch further discloses wherein the modules are removable (Column 2, lines 59-62). While not explicitly disclosing wherein the modules are also interchangeable, this step is notoriously well known in the art and would have been obvious to one of ordinary skill, so that when a particular module is removed for service or for transport, it can be replaced with an interchangeable part and the machine can continue to function.

**Re Claim 3:** Graef in view of Lynch discloses the claimed terminal and Graef further discloses wherein the at least one other module associated with the friction pick mechanism is a friction pick module and the friction pick mechanism is contained within the friction-picking module (See Fig 1, Column 7, lines 34-35).

**Re Claim 4:** Graef in view of Lynch discloses the claimed terminal and Graef further discloses wherein the friction pick module comprises a plurality of friction pick units (Fig 1), each unit including a media container (Fig 1; 44, 46, 48, 50) and a friction pick mechanism (Fig 1 respectively 34, 36, 38, 40).

**Re Claim 5:** Graef in view of Lynch discloses the claimed terminal and Graef further discloses wherein the friction pick units share a common media exit path within the module and leading to the media dispense path (See Fig 1, process 54 across common path 56 to secondary transport 60; Column 7 lines 53-67).

**Re Claim 6:** Graef discloses a self-service terminal comprising:

- Means defining a media dispense path (Fig 1, See arrows related to Refs 54, 56, 60 and 62)
- A friction pick mechanism (See Fig 1 Refs 34, 36, 38 and 40; See Fig 2 and description Column 8 line 39-Column 10 line 50; cites friction portions of picking mechanism)
- A plurality of media modules (Fig 1, 44, 46, 48, 50; Column 7, lines 42-52), each media module operatively associated with a pick mechanism for picking media from the module (Fig 1, 34, 36, 38, 40; Column 7, lines 26-41) and transferring picked media to the media dispense path (Column 7,

lines 53-62), wherein at least one of the modules being associated with a friction pick mechanism (See Fig 2 and description Column 8 line 39- Column 10 line 50; cites friction portions of picking mechanism)

In addition, Graef notes that ATMs can be used to dispense a variety of different medias including cash, tickets, scrip, vouchers or other documents (Column 1, lines 18-35). Furthermore, Graef discloses that the modules may hold a variety of different types of documents in the same machine (Column 7, lines 46-48).

Graef does not explicitly disclose at least one module being associated with a vacuum pick mechanism. Lynch discloses that sheet feeding apparatus, such as the one disclosed by Graef "are commonly of either the vacuum pick or friction pick type," and depending on the type of media involved cites the advantages and disadvantages for each (Column 1, lines 5-20). Some media as Lynch points out is better served with a friction mechanism (medias that need a high feed rate), while other media would be better served with a vacuum mechanism (high porous). Thus, it would have been obvious to anyone of ordinary skill at the time of invention to include the teachings of Lynch to the disclosure of Graef so that an ATM can distribute different types of media in the most efficient and practical way possible.

**Re Claim 7:** Graef in view of Lynch discloses the claimed terminal and Lynch further discloses wherein the media modules are removable (Column 2, lines 59-62). While not explicitly disclosing wherein the modules are also interchangeable, this step is notoriously well known in the art and would have been obvious to one of ordinary skill,

so that when a particular module is removed for service or for transport, it can be replaced with an interchangeable part and the machine can continue to function.

**Re Claim 8:** Graef in view of Lynch discloses the claimed terminal and Graef further discloses wherein the friction picking mechanism is contained within the media module associated with the friction-picking module (See Fig 1, Column 7, lines 34-35).

**Re Claim 9:** Graef in view of Lynch discloses the claimed terminal and Graef further discloses wherein the media module associated with friction pick mechanism comprises a plurality of friction pick units (Fig 1), each unit including a media container (Fig 1; 44, 46, 48, 50) and a friction pick mechanism (Fig 1 respectively 34, 36, 38, 40).

**Re Claim 10:** Graef in view of Lynch discloses the claimed terminal and Graef further discloses wherein the friction pick units share a common media exit path which is within the media module and leads to the media dispense path (See Fig 1, process 54 across common path 56 to secondary transport 60; Column 7 lines 53-67).

**Re Claim 11:** Graef discloses a self-service terminal comprising:

- Means defining a media dispense path (Fig 1, See arrows related to Refs 54, 56, 60 and 62)
- A number of media modules, at least one media module including a plurality of media containers (Fig 1; 44, 46, 48, and 50) and a friction pick mechanism operatively associated with each media container for picking media from the media container (Fig 1, 34, 36, 38, 40) and transferring the picked media to the media dispense path (Fig 1, Ref 54, 56)

Graef does not explicitly disclose wherein the media dispensing modules are removable, however Lynch discloses a self service terminal wherein the modules are removable (Column 2, lines 59-62). It would have been obvious to anyone of ordinary skill in the art at the time of invention to include the teachings of Lynch to the disclosure of Graef so that said modules can be taken from the machine to either be refilled or taken to a remote location for deposit or reconciliation with records related to transactions at the machine.

**Re Claim 13:** Graef discloses the claimed media-dispensing module but does not explicitly disclose means for enabling the media module to be removed and interchangeable. Lynch discloses a self service terminal wherein the modules are removable (Column 2, lines 59-62). It would have been obvious to anyone of ordinary skill in the art at the time of invention to include the teachings of Lynch to the disclosure of Graef so that said modules can be taken from the machine to either be refilled or taken to a remote location for deposit or reconciliation with records related to transactions at the machine.

While the references do not explicitly disclose wherein the modules are also interchangeable, this step is notoriously well known in the art and would have been obvious to one of ordinary skill, so that when a particular module is removed for service or for transport, it can be replaced with an interchangeable part and the machine can continue to function.

***Response to Arguments***

Applicant's arguments filed 7/25/2006 have been fully considered but they are not persuasive.

With regard to claims 12 and 14, the Applicant argues that the canisters disclosed by Graef are non-analogous to the plurality of media storage locations recited by the applicant, specifically with regard to the orientation of the containers. The applicant refers to Figure 1 of his specification. However the claims merely recite "a plurality of media containers," with no other limiting features. The MPEP states that during patent examination, the pending claims must be "given their broadest reasonable interpretation" >*In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).< Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). Furthermore it has been found that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." Since Graef clearly disclosing a plurality of media containers (Figure 1), the rejection is maintained.

With regards to claims 1 and 6 the applicant argues that the examiner has used improper hindsight reasoning to combine a vacuum pick mechanism and a friction pick mechanism and furthermore that the references do not provide proper motivation to combine. In response to applicant's argument that the examiner's conclusion of

obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case Lynch provides a teaching about the benefits of both types of pick mechanisms, depending on the media dispensed and therefore it would have been obvious to anyone of ordinary skill at the time of invention to include the teachings of Lynch to the disclosure of Graef so that an ATM containing multiple media types, can distribute the different types of media in the most efficient and practical way possible.

With regards to the applicants argument that a person of ordinary skill in the art upon reading Lynch and Graef would construct a self service terminal with one kind of picking mechanism, the examiner disagrees. A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. . . . The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). In this case, since Lynch discloses the advantages associated with each pick mechanism (Column 1, lines 5-20; vacuum pick for non-porous; friction pick for photocopier sheets,

tickets ect) and the examiner asserts that a person of ordinary skill in the art, in light of the problem to be solved (i.e a machine that distributes multiple media), would have found it obvious to include both mechanisms in the same machine to take full advantage of the efficiency of both types. Therefore the rejections of claims 1 and 6 are maintained.

Applicant further states that the Office Action offers a contradiction in that page (5), incorrectly states that Graef teaches a friction pick module, even though the Office Action previously admitted that Graef does not teach a friction pick module. There is no citation as to where the examiner stated that Graef does not teach a friction pick module, and contrary to the Applicant's assertion the examiner admitted that Graef does not teach this feature. The examiner did not make such a statement, but rather has stated explicitly that Graef discloses this feature (Page 4 of Office Action; Reference to Graef Fig 2 and Column 8 line 39-column 10 line 50). Instead the examiner states that Graef does not explicitly teach a vacuum mechanism, but includes a teaching of Lynch as a reference. The applicants claim that the Office Action is contradictory is erroneous.

Similar arguments (i.e. non-analogous containers, motivation to combine) were presented for the remaining dependent claims, and the examiner refers applicant back to the above arguments in response.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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